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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,405	09/24/2001	Toru Katagiri	837.1971	5622

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
LEUNG, CHRISTINA Y	
ART UNIT	PAPER NUMBER
2613	

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/960,405	KATAGIRI ET AL.	
	Examiner	Art Unit	
	Christina Y. Leung	2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 November 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,5,7,9-19 and 30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,5,7,9-19 and 30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 17 November 2006 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 4, 5, 7, 10-19, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onaka et al. (JP 11-289296 A; see English-language equivalent document US 6,351,323 B1) in view of Suzuki (US 4,945,531 A) and Kersey et al. (US 6,594,410 B2)..

Examiner notes that because JP 11-289296 A is in Japanese, all references below to its disclosure are made to its English-language equivalent document, US 6,351,323 B1.

Regarding claims 1, 4, 5, 7, 15, and 30 Onaka et al. disclose an optical node device (Figure 2) applicable to an optical network including a closed loop provided by an optical fiber, comprising:

a tunable wavelength selecting element (acousto-optic tunable filter AOTF 10) adapted to input WDM signal light obtained by wavelength division multiplexing a plurality of optical

signals having different wavelengths, the tunable wavelength selecting element having a function of dropping at least one optical signal from the WDM signal light and a function of adding at least one optical signal to at least one unassigned wavelength channel of the WDM signal light (column 7, lines 51-67; column 8, lines 1-39).

Further regarding claims 15 and 30 in particular, Onaka et al. further disclose a system comprising:

a closed loop provided by an optical fiber; and

a plurality of optical node devices arranged along the closed loop, the plurality of optical node ddevices including a first optical node and a second optical node device (Figures 10 and 45; column 18, lines 1-17);

wherein the first and second optical node devices each include a tunable wavelength selecting element as discussed above.

Regarding claims 1, 4, 5, 7, 15, and 30, Onaka et al. do not specifically disclose a wavelength selecting filter for removing noise present in bands other than a signal band of each optical signal and comprising a demultiplexer and multiplexer connected together and including other details as specifically recited by claims 1, 15, and 30. However, Onaka et al. do disclose that the signals in their system may include undesirable amplified spontaneous emission (ASE) noise (column 8, lines 53-58).

Suzuki further teaches a system related to the one disclosed by Onaka et al. including wavelength multiplexed optical signals and further teaches a means for filtering ASE noise comprising a wavelength selecting filter (optical filter 100 shown in Figure 1), the filter comprising:

an optical demultiplexer 101 having an input port for inputting WDM signal light output and N output ports for respectively outputting the N optical signals separated from the WDM signal light; and

an optical multiplexer 102 having N input ports for respectively inputting N optical signals output from the demultiplexer, and an output port for outputting WDM signal light obtained by wavelength division multiplexing the N optical signals input to the N input ports (column 2, lines 47-56).

Further regarding claim 4 in particular, in the wavelength selecting filter taught by Suzuki, the input ports of the optical multiplexer are optically connected to the output ports of the optical demultiplexer, respectively (Figure 1).

Further regarding claim 5 in particular, in the wavelength selecting filter taught by Suzuki, the input port and the i-th output port of the optical demultiplexer are coupled by the transmission band of the optical demultiplexer including the wavelength of any one of the wavelength channels of the WDM signal light in the system; and the j-th input port and the output of the optical multiplexer are coupled by the transmission band of the multiplexer including the wavelength of any one of the wavelength channels of the WDM signal light in the system (Figures 1 and 2A-C).

Further regarding claim 7 in particular, in the wavelength selecting filter taught by Suzuki, the transmission band of each of the optical demultiplexer and the optical multiplexer per wavelength channel is wider than the band of each wavelength channel of the WDM signal light in the system (Figures 2A-C; column 3, lines 7-41).

Regarding claims 1, 4, 5, 7, 15, and 30, it would have been obvious to a person of ordinary skill in the art to additionally include a wavelength selecting filter as taught by Suzuki in the system disclosed by Onaka et al. (wherein the demultiplexer and multiplexer of the filter is connected to the elements disclosed by Onaka et al. and arranged on the closed loop) in order to remove ASE noise from the WDM signal light in the system and thereby more effectively transmit desired signals in the system. One in the art would have been particularly motivated to combine the filter taught by Suzuki with the system disclosed by Onaka et al. because Onaka et al. already discloses that the signals in their system may include undesirable amplified spontaneous emission (ASE) noise (Onaka et al., column 8, lines 53-58).

Further regarding claims 1, 4, 5, 7, 15, and 30, Suzuki does not specifically further teach that the transmission band per wavelength channel of the optical demultiplexer is different from the transmission band per wavelength channel of the optical multiplexer or that either transmission band per wavelength channel has a central wavelength longer or shorter than the central wavelength of each wavelength channel of the WDM signal light.

However, Kersey et al. teach a system related to the one described by Onaka et al. in view of Suzuki, including transmitting and filtering wavelength division multiplexed optical signals. Kersey et al. further teaches filtering an optical WDM signal through one filter and then another filter, wherein the transmission band (labeled "47'" in Figure 11) of the first filter has a central wavelength λ_A substantially coinciding with a first wavelength shorter than the central wavelength λ_C of the desired wavelength channel of the WDM signal; and

the transmission band 48' of the second filter has a central wavelength λ_B substantially coinciding with a second wavelength longer than the central wavelength λ_C of the desired wavelength channel of the WDM signal (Figure 11; column 16, lines 7-34).

Regarding claims 1, 4, 5, 7, 15, and 30, it would have been obvious to a person of ordinary skill in the art to provide a first central wavelength shorter than the central wavelength of the desired channel and a second central wavelength longer than the central wavelength of the desired channel as taught by Kersey et al. in the demultiplexer/multiplexer filter structure taught by Suzuki (in the system suggested by Onaka et al. in view of Suzuki) in order to advantageously provide a narrower filter band and therefore filter the desired channels more precisely.

Regarding claim 10, Onaka et al. disclose that the tunable wavelength selecting element comprises an acousto-optic tunable filter (AOTF 10 as shown in Figure 2; column 7, lines 51-67).

Regarding claims 11 and 17, Onaka et al. disclose the tunable wavelength selecting element (AOTF 10 shown in Figure 2) has a first input port ("INPUT") for inputting the WDM signal light, a second input port ("ADD") for inputting an optical signal to be added to the WDM signal light, a first output port ("OUTPUT") for outputting an optical signal to be passed through the tunable wavelength selecting element, and a second output port ("DROP") for outputting an optical signal to be dropped from the WDM signal light.

Regarding claims 12 and 18, Onaka et al. further disclose that the node device (Figure 2) further comprises:

an optical coupler 12 having a plurality of input ports and an output port connected to the second input port of the tunable wavelength selecting element 10;

an optical modulator 16 connected to each of the plurality of input ports of the optical coupler; and

a tunable light source (including laser diodes 19 in combination with tunable filters 14) connected to the optical modulator (column 8, lines 20-39).

Regarding claims 13 and 19, Onaka et al. further disclose that the node device (Figure 2) further comprises:

an optical coupler 11 having an input port connected to the second output port of the tunable wavelength selecting element 10, and a plurality of output ports;

a tunable filter 13 connected to each of the plurality of output ports of the optical coupler; and

an optical receiver 17 connected to the tunable filter (column 7, lines 64-67; column 8, lines 1-9).

Regarding claims 14 and 16, Onaka et al. further disclose an optical amplifier (such as amplifiers 30 or 34 on the transmission line as generally shown in Figure 3, or other optical amplifiers shown in other figures including Figure 10, etc.; column 8, lines 66-67; column 9, lines 1-41).

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Onaka et al. in view of Suzuki and Kersey et al. as applied to claim 4 above, and further in view of Otsuka et al. (JP 11-218790 A).

Examiner notes that because JP 11-218790 A is in Japanese, all references below to its disclosure are made to its English-language equivalent document, US 6,538,782 B1.

Regarding claim 9, Onaka et al. in view of Suzuki and Kersey et al. describe a system as discussed above with regard to claims 1 and 4 including an optical demultiplexer and multiplexer, but they do not specifically suggest that the demultiplexer and multiplexer are arrayed waveguide gratings.

However, it is well known in the art that wavelength demultiplexers and multiplexers such as in the system described by Onaka et al. in view of Suzuki and Kersey et al. may be implemented in several ways, and Otsuka et al. specifically teach implementing demultiplexers and multiplexers as arrayed waveguide gratings (column 1, lines 59-67; column 2, lines 1-15).

Regarding claim 9, it would have been obvious to a person of ordinary skill in the art to use arrayed waveguide gratings as taught by Otsuka et al. in the system described by Onaka et al. in view of Suzuki and Kersey et al. as an engineering design choice of a known way to implement the demultiplexer and multiplexer already disclosed. The claimed differences exist not as a result of an attempt by Applicants to solve an unknown problem but merely amount to the selection of expedients known as design choices to one of ordinary skill in the art.

Response to Arguments

5. Applicants' arguments filed 17 November 2006 have been fully considered but they are not persuasive.

Examiner agrees with Applicants' general assertion on page 10 of their response that Onaka et al. do not specifically disclose a wavelength selecting filter for removing noise containing details as recited by Applicants' claims. However, Examiner respectfully disagrees with Applicants' assertion on page 10 of their response that "claim 1 is patentable over Onaka, as Onaka fails to disclose or suggest the features of the present invention identified...." In response

to Applicants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Specifically, as discussed in detail in the rejections above, Suzuki is relied upon to provide a teaching of a wavelength selecting filter (comprising a demultiplexer and multiplexer and other details as discussed above) for removing the noise present in any bands other than a signal band of each optical signal passing through the tunable wavelength selecting element disclosed by Onaka et al.

In response to Applicants' additional argument that there is no suggestion to combine the Onaka et al. and Suzuki references because, as Applicants allege on page 10 of their response, "the optical filter 100" taught by Suzuki "is not connected to a tunable wavelength-selecting element," Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Onaka et al. and Suzuki are related to wavelength division multiplexed optical communications systems, and Examiner especially notes that Onaka et al. themselves disclose that the unwanted noise that Suzuki's filter is designed to remove may be present in their system (Onaka et al., column 8, lines 53-58).

In response to Applicants' argument on page 11 of their response that "Kersey does not add any relevant information to the combination" because Kersey does not teach a demultiplexer and multiplexer as recited in the claims, Examiner respectfully submits that the above rejections rely on Suzuki to provide a teaching of a noise-removing wavelength selecting filter comprising a demultiplexer and multiplexer as recited, while Kersey et al. is further relied upon for their teaching of how to improve the filtering characteristics of wavelength filtering elements like the one already taught by Suzuki. Again, in response to Applicants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina Y. Leung whose telephone number is 571-272-3023. The examiner can normally be reached on Monday to Friday, 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on 571-272-3022. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CHRISTINA LEUNG
PRIMARY EXAMINER